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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,454	08/24/2001	Carol J. Collins	NEU-40	2232

27777 7590 04/07/2003
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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/07/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,454

Applicant(s)

COLLINS ET AL.

Examiner

Humera N. Sheikh

Art Unit

1615

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2003 (paper no. 11).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of the Application

Acknowledgement is made of the receipt of the request for Extension of Time (1 month) filed 01/08/03, the Amendment filed 01/08/03 and the Petition under 37 CFR 1.137(f) filed 01/10/03.

The claim objection for claim 4 has been withdrawn.

Claims 1-24 are pending. Claims 1-24 remain rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shukuzaki *et al.* (US Pat. No. 5, 266,32; collectively, "Shukuzaki") in view of Sunkel *et al.* (US Pat. No. 6,542,598 B2; collectively, "Sunkel").

Shukuzaki teach an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see reference column 2); (col.7); (col.8, lines 47-56); and examples. Specific examples of the low viscosity oils are: dimethylpolysiloxane, methylphenylpolysiloxane, octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane and the like (col. 7, lines 3-16). Various cosmetic powders, such as mica can be included in the composition (col. 7, lines 32-45). The make-up cosmetic can be applied to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56).

Shukuzaki is deficient only in the sense that he does not explicitly teach the make-up cosmetic in the form of mascara.

Sunkel teaches cosmetic compositions comprising siloxane elastomers wherein the composition may be in the form of a foundation, *mascara*, eye shadows, powders, blushers, lip color and the like (see reference column 2, lines 35-55); Example II and claims 1, 13 and 20.

Therefore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel

Art Unit: 1615

within the teachings of Shukuzaki because Sunkel explicitly teaches cosmetic compositions comprising organopolysiloxane elastomers wherein the cosmetic composition may be in various forms, such as foundation, *mascara*, eye shadows, powders, lip color, blushers and the like and similarly, Shukuzaki teaches the use of polyorganosiloxane elastomers in a make-up cosmetic wherein the composition can be applied to foundations, eye shadows, face powder, lip stick and the like and can take various forms including a solid, stick. The expected result would be an improved, cosmetic composition, such as in the form of mascara, that provides softening, moisturizing and conditioning properties.

Prior Art made of record and deemed relevant by the Examiner:

US Pat. No. 5, 412,004 Tachibana *et al.* 02/1994

Response to Arguments

The applicant's arguments filed 01/08/2003 have been fully considered, but were not found to be persuasive.

The applicant argued, "Shukuzaki is silent with respect to mascara, which is applied to the eyelashes and eyebrows, and that, Shukuzaki relates to cosmetics that are applied to the skin and that the compositions of Shukuzaki actually teaches away from mascaras, which require stickiness in order to help the compositions adhere to the hairs."

These arguments have been fully considered, but were not found to be persuasive. Shukuzaki teaches an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see column 2); (col.7); (col.8, lines 47-56); and examples. The make-up cosmetic can be applied to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56). Although Shukuzaki does teach that the composition can be applied in various forms (i.e., foundation, eye shadow, powders), Shukuzaki is lacking only in the sense that he does not explicitly teach the composition in the form of mascara. Sunkel resolves this only deficiency of Shukuzaki and was relied upon for the generic teaching of polysiloxane elastomers in a mascara formulation. Sunkel also teaches that the cosmetic composition may be in the form of foundations, eye shadows, powders, lip colors and the like and can provide improved skin-feel properties (see col. 1, line 59 through col. 2, line 55). The applicant's arguments therefore are not deemed persuasive since the prior art teaches a similar cosmetic formulation having similar ingredients for the same intended purpose as the applicant.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns

April 03, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600